

DEC 23 2003

KOBAYASHI, et al.  
09/869,837In re Application of:  
Application No.  
Filed:  
For:

METHOD OF SUPPRESSING ONGOING ACUTE ALLOGRAFT REJECTION

1646-  
PATENT  
FILEDAttorney Docket No. 212653/PUSAWA  
Client Reference No. PUS-19342/ET/SEMail Stop  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RECEIVED

JAN 07 2004

TECH CENTER 1600/2900

Sir:

Small entity status is claimed for this application under 37 CFR 1.27.

Petition for an extension of time for the period noted below, as well as for any additional period necessary to render the present submission timely. Please charge Deposit Account No. 12-1216 for the appropriate petition fee.

Other:

Please charge Deposit Account No. 12-1216 in the total amount indicated below. A duplicate copy of this transmittal sheet is enclosed herewith.

| TIME EXTENSION<br>PETITION FEE                                |   |       | one-month                                      |                            | \$ 0.00 |                       | OTHER THAN A SMALL<br>ENTITY |                       |
|---|---|-------|--|----------------------------|---------|-----------------------|------------------------------|-----------------------|
|   |   |       | subtract time extension<br>fee previously paid |                            | none    |                       | (\$ 0.00)                    |                       |
| <hr/>   |   |       |  |                            |         |                       |                              |                       |
| CLAIM FEE   | CLAIMS<br>REMAINING<br>AFTER<br>AMENDMENT |       | HIGHEST<br>NUMBER<br>PREVIOUSLY<br>PAID FOR    | EXTRA<br>CLAIMS<br>PRESENT | RATE    | ADDT.<br>CLAIM<br>FEE | RATE                         | ADDT.<br>CLAIM<br>FEE |
| TOTAL   | 11  | MINUS | 20   | =0                         | x 9=    | \$                    | x 18=                        | \$                    |
| INDEPENDENT   | 2   | MINUS | 3  | =0                         | x 43=   | \$                    | x 86=                        | \$                    |
| <input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE CLAIM |   |       |  |                            | + 145=  | \$                    | + 290=                       | \$                    |
| <hr/>   |   |       |  |                            |         |                       |                              |                       |
| TOTAL AMOUNT TO BE CHARGED TO DEPOSIT ACCOUNT                 |   |       |  |                            | TOTAL   | \$                    | TOTAL                        | \$110.00              |

The Commissioner is hereby authorized to charge any deficiencies in the following fees associated with this communication or credit any overpayment to Deposit Account No. 12-1216.

Any filing fees under 37 CFR 1.16 for the presentation of extra claims.

Any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

Jeremy M. Day, Reg. No. 38,587

LEVDIG, VOL &amp; MAYER

100 Thirteenth Street, N.W., Suite 300

Washington, DC 20005-3960

(202) 737-6770 (telephone)

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Date 23 Dec. 2003



1646

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PATENT  
Attorney Docket No. 212653/FUJISAWA  
Client Reference No. PUS-19342/ET/SE

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

KOBAYASHI et al.

Application No. 09/889,837

Art Unit: 1646

Filed: July 20, 2001

Examiner: Prema Maria Mertz

For: METHOD OF SUPPRESSING  
ONGOING ACUTE ALLOGRAFT  
REJECTION

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JAN 07 2004

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**RESPONSE TO OFFICE ACTION**

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Official Action mailed November 6, 2003, Applicants petition for a one month extension of time, extending the date for response to and including January 6, 2004, submit the requisite fee therefor, and request that the following remarks be considered and the referenced application be amended as shown below.

*Request for Change of Attorney's Address in Application*

Please address all correspondence for this case as follows:

Leydig, Voit & Mayer  
700 Thirteenth Street, N.W., Suite 300  
Washington, D.C. 20005-3960  
Telephone: (202) 737-6770  
Facsimile: (202) 737-6776

The change in address is requested as this application will now be prosecuted in Leydig, Voit & Mayer's Washington, D.C. office rather than in Leydig, Voit & Mayer's Chicago, Illinois office.

The Official Action mailed November 6, 2003 asserts there are two distinct inventions (identified as Groups I - II) claimed in the referenced application and there is a lack of unity. The Official Action asserts that the groups do not relate to a single inventive concept under PCT Rule 13.1, as they lack the same or corresponding special technical feature. The Official Action also asserts the inventions are independent and distinct and would require independent searches and that the searches for the inventions would not be coextensive.

#### *ELECTION OF GROUP WITH TRAVERSE*

In order to comply with the requirements of the Patent and Trademark Office, Applicants provisionally elect, *with traverse*, Group I (claims 1-3, 6-10, and 13) drawn to a method of suppressing ongoing acute allograft rejection, comprising administering an IL-10 antibody.

#### *DISCUSSION*

It is respectfully submitted that the restriction is improper. The claims of both Groups relate to suppressing ongoing allograft rejection and administering to a host experiencing ongoing acute allograft rejection an interleukin-10 (IL10) inhibitor. Thus, any search and consideration of the claimed subject matter of Group I will likely overlap and encompass that for the claimed subject matter of Group II. Accordingly, the searches for these two groups of claims cannot in any way be said to be completely "independent." This does not mean that the claims necessarily stand or fall together, but the overlapping nature of the searches remains and mitigates against a restriction requirement.

Examination of the patent application would be most expeditious by examining all pending claims together. As Section 803 of the MPEP requires,

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct and/or independent inventions.

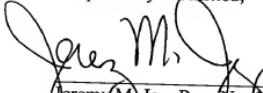
The restriction requirement is improper because the Examiner has not shown that a search and examination of the entire application would, indeed, cause a *serious* burden. In fact, a serious burden would arise only if examination of the patent application were restricted to one of the claim groups. Filing additional patent applications containing the non-elected claims would unnecessarily burden (1) the Patent and Trademark Office, since it must assume the additional labor involved in examining at least two separate applications; (2) the public, since it will have to analyze at least two patents (assuming the subject matter of each claim group is found patentable) to ascertain all of the claimed subject matter; and

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Application No. 09/889,837

(3) the Applicants, since the Applicants must bear the substantial financial burden and delays associated with prosecution of multiple patent applications and the payment of maintenance fees for multiple patents.

While the inventions defined by the claims may be distinct and independent, there is no demonstration that the search and examination of all the pending claims would entail a serious burden to the Examiner. In particular, it is submitted that any additional burden on the Examiner in considering Groups I and II together is not so serious as to require restriction, and therefore, Applicants respectfully request withdrawal of the restriction requirement.

Respectfully submitted,



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Date: 23 Dec. 2003

Amendment or ROA - Regular (Revised 9/03/03)